REMARKS:

In the Office Action mailed on August 8, 2006, the Examiner objected to claim 19 and rejected claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-25. An Amendment was filed on September 22, 2006 in which claims 1, 8, 15 and 22-25 were amended. In response, the Examiner issued an Advisory Action on October 13, 2006.

For convenience of the Examiner, the amendments and arguments presented in the Amendment of September 22, 2006 are reproduced herein. Further, claim 26 is added herein. Claims 2, 3, 5, 6, 9, 10, 12, 13, 16, 17, 19 and 20 remain cancelled.

Thus, claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-26 are pending and under consideration. The rejections are traversed below.

CLAIM OBJECTION:

On page 2 of the outstanding Office Action, the Examiner objected to claim 19. Claim 19 is indicated herein as being cancelled.

Therefore, withdrawal of the objection is respectfully requested.

REJECTION UNDER 35 U.S.C. §101:

Claim 25 was rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

The Examiner asserts that the invention of claim 25 does not have a practical application. Independent claim 25 as amended recites, "searching for a keyword within contents of the corresponding document and a character recognition indicating character strings of the note handwritten", where "a result of the searching indicates whether the keyword is contained in said character strings of the note handwritten and said contents of the corresponding document."

Accordingly, the claimed invention in claim 25 provides a method of managing both the document and the note written on the document subsequent to printing without having to maintain a hard copy of the document with the note, a useful, concrete, tangible result.

Thus, it is respectfully submitted that because independent claim 25 satisfies the requirements of 35 USC §101, withdrawal of the rejection is requested.

REJECTION UNDER 35 U.S.C. § 112:

On page 3 of the outstanding Office Action, the Examiner rejected claim 23 as being indefinite. Claim 23 is amended herein.

Therefore, withdrawal of the rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,533,168 (<u>Ching</u>) and U.S. Patent No. 4,748,678 (<u>Takeda</u>).

In response to the previous arguments, the Examiner points to col. 4, lines 14-24, 49-54, col. 10, lines 39-42 and col. 14, lines 3-6 of <u>Ching</u>. However, these portions of <u>Ching</u> only discuss tracking data associated with retail transactions at a point of sale where annotations are stored with the transaction data based on their association with the transaction data (see, col. 4, lines 9-24). In <u>Ching</u>, if a purchaser wants to return a merchandise to a vendor, relevant transaction information is obtained by scanning a receipt (see, col. 8, lines 13-31) that may contain a human readable version (107) converted into text for determination of association to classify the annotation (see, col. 10, lines 47). For example, if "home office" is annotated on a designated field on the receipt, the information is stored in association with other "home office" entries (see, col. 10-47-55).

The Examiner relies on <u>Takeda</u> as teaching correlating the original document with information about the note and obtaining the image data of the note by taking a difference between the original document and the read image. <u>Takeda</u> is directed to document retrieval based on positional indexing of secondary data used to extract contents from a document image. For example, coordinates specifying regions of the secondary data on the original document are stored and used to retrieve sections of the document image specified by a coordinate (see, Fig. 12 and corresponding text).

Independent claim 1 recites, "searching attributes and contents of the electronic document and the recognition result of character stings of the hand-written note responsive to a search keyword input from a user", and "displaying a search result indicating whether the search keyword is contained in the attributes and contents of the electronic document or said character strings." Claim 1 further recites that "the information about the hand-written note includes image data of the hand-written note is obtained by taking

a difference between a generated image generated from the electronic document and the read image." Independent claims 8, 15, 22 and 23 recite similar features.

Independent claim 24 recites, "extracting by determining a difference between the electronic document and the scanned printed document including the handwritten note and storing the handwritten note and recognized character strings linked to the electronic document." Claim 24 further recites that a search is conducted using "attributes and contents of the electronic document and the recognized character" upon input of a search keyword and "a search result indicating whether the search keyword is contained in the attributes and contents of the electronic document or said character strings is provided."

Similarly, independent claim 25 recites, "extracting information of a handwritten note on a document subsequent to printing the document by comparing the document with a corresponding document prior to said printing" and "searching for a keyword within contents of the corresponding document and a character recognition", where "a result of the searching indicates whether the keyword is contained in said character strings of the note handwritten and said contents of the corresponding document."

It is submitted that the independent claims are patentably distinguishable over <u>Ching</u> and <u>Takeda</u>.

For at least the above-mentioned reasons, claims depending from the independent claims are patentably distinguishable over <u>Ching</u> and <u>Takeda</u>. The dependent claims are also independently patentable. For example, claim 19 recites, "searching contents of the electronic document and the recognition result in accordance with a search keyword input from a user, and displaying a search result." <u>Ching</u> and <u>Takeda</u> do not teach or suggest these features of claim 19.

Therefore, withdrawal of the rejection is respectfully requested.

NEW CLAIM:

New claim 26 has been added to recite, " removing contents printed on an electronic document to generate an image of a note handwritten on the electronic document subsequent to printing and storing character strings contained in the note." Claim 26 further recites, "searching the stored character strings for a keyword" and "providing the character strings and the image of said note as a result when said searching results in the keyword matching at least one of the character strings."

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Ching and <u>Takeda</u>, alone or in combination, do not teach or suggest the above-discussed features of claim 26 including "searching the stored character strings for a keyword" and "providing the character strings and the image of said note as a result when said searching results in the keyword matching at least one of the character strings."

Therefore, it is submitted that new claim 26 is patentably distinguishable over <u>Ching</u> and <u>Takeda</u>.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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